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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/684,616 | 10/14/2003 | Srinivasan Venkatesan | 2091 | 4227 |

24963 7590 07/31/2006

ENERGY CONVERSION DEVICES, INC.
2956 WATERVIEW DRIVE
ROCHESTER HILLS, MI 48309

| EXAMINER | |
|---|---|
| WARTALOWICZ, PAUL A | |
| **ART UNIT** | **PAPER NUMBER** |
| 1754 | |

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| **Advisory Action Before the Filing of an Appeal Brief** | **Application No.** 10/684,616 | **Applicant(s)** VENKATESAN ET AL. | |
|---|---|---|---|
| | **Examiner** Paul A. Wartalowicz | **Art Unit** 1754 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 10 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 1-13.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

7/27/06

COLLEEN P. COOKE
PRIMARY EXAMINER

**Advisory Action**

Continuation of 7: The amendments filed on July 10, 2006 that have been entered are merely cosmetic and do not change the rejection as made final on April 19, 2006.

Continuation of 11:

Applicant's arguments filed July 10, 2006 have been fully considered but they are not persuasive.

Applicant argues that the '033 reference does clearly suggest that the hydrogen can be stored in a separate storage tank from the disclosure on column 14, lines 50-51.

This argument is not persuasive for the following reason: In the disclosure of '033 on column 14, lines 49-50, the following is stated: "the waste reservoir can also store hydrogen". The mere fact that the disclosure states: "hydrogen can be vented off from the waste reservoir to a separate hydrogen storage tank" does not preclude the fact that hydrogen can be stored in the waste reservoir.

Applicant argues that the '806 reference teaches that hydrogen produced from a separate reaction process can be stored by the use of hydrogen storage tanks.

This argument is not persuasive for the following reason: The '806 reference is relied upon to teach that the metal hydride bed can adsorb hydrogen and vent hydrogen (col. 4, lines 58-61). This teaching is combined with the '033 reference which teaches a metal hydride in contact with a catalyst system. The '809 reference is not relied upon to teach how or where the hydrogen is produced. In response to applicant's arguments

against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the combined teachings of the '033 and '809 references would include a slurry storage tank 30, a reaction tank 70, and a hydrogen storage alloy tank for hydrogen storage.

This argument is not persuasive for the following reason: The '809 reference is relied upon to teach that it is known to adsorb hydrogen using a hydride bed. This is combined with the '033 reference in which it is disclosed that the borohydride is contacted with catalyst system in the reaction chamber (col. 14, lines 10-14). After contacting the catalyst, the hydrogen is then adsorbed to the metal hydride at least partially in the reaction chamber to maintain hydrogen pressure in the apparatus. The teaching of the '809 reference as to the metal hydride bed adsorbing hydrogen is combined with the '033 reference to render the claimed invention obvious. In response to applicant's argument that the combination of the '809 and the '033 references teach a slurry storage tank 30, a reaction tank 70, and a hydrogen storage alloy tank for hydrogen storage, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).